

### **REMARKS**

Claims 1-32 were previously pending, of which claims 12 and 18 have been canceled, claims 1, 11, 19, 20, 23, 24, 25, 26, 27 and 32 have been amended. Reconsideration of presently pending claims 1-11, 13-17 and 19-32 is respectfully requested in light of the above amendments and the following remarks.

#### **Claim Objection – Informality**

Claim 11 is objected to because of the following informalities: The claim recites “a plurality of database.” Claim 11 has been amended as required to recite “plurality of databases”, without an intended change to the claim scope. As such, the Applicants kindly request the objection be withdrawn.

#### **Claim Rejections – 35 USC § 112**

Claims 18 and 19 were rejected under 35 USC § 112, first paragraph, as failing to comply with the enablement requirement.

Claim 18 has been cancelled and claim 19 has been amended to depend from independent claim 1. Thus, it is submitted that these rejections are moot and withdrawal of them is respectfully requested.

Claims 18, 19 and 23-27 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully disagree.

Claim 18 has been cancelled and claim 19 has been amended to depend from independent claim 1. Thus, it is submitted that these rejections are moot and withdrawal of them is respectfully requested.

Claims 23 and 24 have been amended to now depend from claim 21, which corrects any antecedent basis issue for these claims. Thus, it is submitted that these rejections are moot and withdrawal of them is respectfully requested.

Claims 25 and 26 have been amended to now depend from claim 22, which corrects any antecedent basis issue for these claims. Thus, it is submitted that these rejections are moot and withdrawal of them is respectfully requested.

Claim 27 depends from claim 20 and has been amended to include the phrase “the design technical documents database”. This phrase is supported with proper antecedent basis in claim 20. Thus, it is submitted that these rejections are moot and withdrawal of them is respectfully requested.

### **Claim Rejections – 35 USC § 101**

Claims 1-32 were rejected under 35 USC 101 as being directed to non-statutory subject matter. This rejection is respectfully traversed.

Each of independent claims 1, 20 and 32 include limitations of providing a search result to a user “as a visual depiction of the search result using a display monitor”. It is well settled under *In re Abele*, 684 F2d 902, 214 USPQ 682 (CCPA 1982) that an electronic transformation of data into a visual depiction of a physical object is patentable under 35 U.S.C. 101. See also *In re Bernard L. Bilski and Rand A. Warsaw*, 88 USPQ2d 1385 at 1397 (Fed.Cir. 2008). Thus, it is submitted that independent claims 1, 20 and 32 and their independent claims are statutory subject matter for displaying the search result (e.g., a list of customers) using a display monitor. As such, withdrawal of these rejections is respectfully requested.

It is submitted that the amendments to the claims relating to this subject are supported, at least, in Figs. 1-6 and related text of the pending application. See, for example, specification text on user interface 514, estimation module 506 and I/O device 406 (e.g., a monitor).

### **Rejections Under 35 U.S.C. §103**

Claims 1-8, 12-15 and 20-27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Oppedahl et al. (US Patent No. 6,789,092 hereinafter referred to as “Oppedahl”) in view of Yoshida et al. (US Patent No. 6,212,518 hereinafter referred to as “Yoshida”). Claims 9-11 and 28-30 were rejected under 35 U.S.C. §103(a) as being unpatentable over Oppedahl in view of Yoshida and further in view of Kuo (US Patent Publication No. 2005/0021165 hereinafter referred to as “Kuo”). Claims 16-19, 31 and 32 were rejected under 35 U.S.C. §103(a) as being unpatentable over Oppedahl in view of Yoshida and further in view of Mir (US Patent No. 6,938,081 hereinafter referred to as “Mir”). Applicant traverses this rejection on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to claims 1-11, 13-17 and 19-32.

In *KSR Int'l. Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1739 (2007), the Court stated that “a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. Although common sense directs one to look with care at a patent application that claims as innovation the combination of two known devices according to their established functions, it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. This is so because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity will be combinations of what, in some sense, is already known.” *Id.* at 1741 (emphasis added).

As the PTO recognizes in MPEP §2142:

... The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness...

In the present application, a *prima facie* case of obviousness does not exist for the claims as herein amended for the reasons set forth below.

**The Examiner has not shown that all words in the claim have been considered**

MPEP 2143.03 states that “[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.” Quoting *In re Wilson*, 424 F.2d 1382, 1385 (CCPA 1970). However, in the present matter, the Examiner has not shown that all words in the claim have been considered. For example, independent claim 1 recites “an extraction module, responsive to the user interface, configured to search and extract information of a customer who has used a microelectronics fabrication design technical documents database, wherein the design technical documents database includes information related to the technology process.” The Examiner has shown “parsing software that extracts information from documents such as filing data, the examining group and the recent status” for databases of the U.S. Postal Service and the U.S. Patent and Trademark Office. See Office Action mailed January 26, 2009, page 5 and Oppedahl, Col. 3, lines 11-25. It is submitted that it should be clear to a person having ordinary skill in the art that databases for the U.S. Postal Service and the U.S. Patent and Trademark

Office including filing data, the examining group and the recent status is not searching a “microelectronics fabrication design technical documents database,” as is recited in claim 1.

Thus, for this independent reason alone, the Examiner’s burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

#### **Independent Claim 20**

Claim 20 recites “searching, according to the search scope and the search scheme, a microelectronics fabrication design technical documents database that includes information related to the technology process to determine a customer impacted by the revision”. As discussed above, with respect to claim 1, it is submitted that the references fail to teach or suggest such limitations. Thus, the rejection of claim 20 is respectfully traversed.

#### **Independent Claim 32**

Claim 32 recites “implementing a search of a plurality of microelectronics fabrication design databases according to the search scope and the search scheme”. As discussed above, with respect to claim 1, it is submitted that the references fail to teach or suggest such limitations. Thus, the rejection of claim 32 is respectfully traversed.

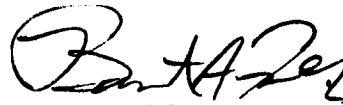
#### **Dependent Claims 2-11, 13-17, 19 and 21-31**

Dependent claims 2-11, 13-17, 19 and 21-31 depend from and further limit independent claims 1, 20 and 32 and therefore are deemed to be patentable over the prior art.

**CONCLUSION**

An early formal notice of allowance of claims 1-11, 13-17 and 19-32 is requested. A personal or telephonic interview is respectfully requested to discuss any remaining issues in an effort to expedite the allowance of this application.

Respectfully submitted,



Bart A. Fisher  
Registration No. 55,181

Dated: 4-2-09  
HAYNES AND BOONE, LLP  
Customer No.: 42717  
Telephone: 512/867-8459  
Facsimile: 214/200-0853

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Bonnie Boyle  
Bonnie Boyle